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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/053,482	11/02/2001	Keith Wood	10743/3	3594
757 . 7	590 10/21/2005		EXAMINER	
BRINKS HOFER GILSON & LIONE			GITOMER, RALPH J	
P.O. BOX 10395 CHICAGO, IL 60610			ART UNIT	PAPER NUMBER
,			1655	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)		
	10/053,482	WOOD ET AL.		
Office Action Summary	Examiner	Art Unit		
	Ralph Gitomer	1655		
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address		
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be time will apply and will expire SIX (6) MONTHS from the cause the application to become ABANDONET	l. ely filed the mailing date of this communication. 0 (35 U.S.C. § 133).		
Status				
1) ⊠ Responsive to communication(s) filed on <u>03 Octoor</u> 2a) □ This action is <b>FINAL</b> . 2b) ⊠ This     3) □ Since this application is in condition for alloward closed in accordance with the practice under Expression.	action is non-final. nce except for formal matters, pro			
Disposition of Claims				
4) ☐ Claim(s) 1-33,38-65 and 67-83 is/are pending i  4a) Of the above claim(s) 65,67,75-78 and 338  5) ☐ Claim(s) is/are allowed.  6) ☐ Claim(s) 1-33,68-74 and 79-83 is/are rejected.  7) ☐ Claim(s) is/are objected to.  8) ☐ Claim(s) are subject to restriction and/or  Application Papers  9) ☐ The specification is objected to by the Examine.	is/are withdrawn from considerat	ion.		
10) The drawing(s) filed on is/are: a) access applicant may not request that any objection to the confidence of th	epted or b) objected to by the Eddrawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e 37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).		
Priority under 35 U.S.C. § 119				
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No.</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>				
Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail De 5) Notice of Informal P 6) Other:			

Application/Control Number: 10/053,482

Art Unit: 1655

claims 1-33, 68-74, 79-83 are considered here.

Claims 1-33, 68-74, 79-83 are rejected under 35 U.S.C. 112, first paragraph, as

The RCE Request and amendment received 10/3/05 have been entered and

failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in

the art to which it pertains, or with which it is most nearly connected, to make and/or use

the invention.

The core compound of formula XII is old. A preliminary search revealed too

many citations to present here that read on the compounds as claimed. On page 19 of

the present specification, formula XII is shown where R11, R14 or R15 is a cleavable

protecting group and the structure is a protecting group on the carbonyl of a

coelenterazine. As claimed, R11, R14, or R15 can be anything except not all can be

acetyl groups. Such compounds would not function as described and are old.

Applicant's arguments filed 10/3/05 have been fully considered but they are not

persuasive.

Applicants argue that the specification teaches how to make and use the

compounds and each of the R groups are defined.

It is the examiner's position that the above rejection is made under 35 USC 112,

first paragraph, where one of skill in this art could not make and use each and every of

the innumerable compounds encompassed by the claims as claimed.

Application/Control Number: 10/053,482

Art Unit: 1655

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-33, 68-74, 79-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Each of the following applies in all occurrences.

In claim 1 "a protecting group that is removable by an enzyme" is indefinite as it could read on H or a methyl group or most anything. What is protected such as the ring is not set forth. This is so indefinite as to be unsearchable. Claim 3 fails to further limit claim 1 because the stated R groups are attached to O. Claim 33 describes a compound in functional terms where one would not know the metes and bounds of the claim.

Applicant's arguments filed 10/3/05 have been fully considered but they are not persuasive.

Applicants argue that the specification defines "a protecting group that is removable by an enzyme" and each of the R groups are defined. In claim 33 the compound is a modified coelenterazine compound.

Application/Control Number: 10/053,482 Page 4

Art Unit: 1655

It is the examiner's position that "enzyme removable group" reads on H as well as most any compound, known or unknown. The limitations of the specification are not read into the claims. One would not know if a modified coelenterazine compound is encompassed by claim 33 because the claims does not state how the compound is modified.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ralph Gitomer whose telephone number is (571) 272-0916. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ralph Gitomer Primary Examiner Art Unit 1655

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